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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/539,506

Filing Date: January 10, 2006

Appellant(s): ERNST ET AL.

William M. Schertler
(Reg. No. 35, 348)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 05/07/2008 appealing from the Office action mailed on 08/07/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/0169714

Nakajima

09-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by

Nakajima (US 2003/0169714) (hereinafter Nakajima).

Regarding claim 1, Nakajima teaches dynamic or static assignment of a unique identifier of the first network for a terminal, during or prior to the latter's connection to the first network by means of the second network (Nakajima: see figures 2-3 and paragraph

[0036]: when connection is established, service terminal send an ID and an IP address to mobile terminal); storage of a combination of at least the unique connection identifier of the second network by means of which the connection was made, and the unique identifier of the first network in an authentication unit (Nakajima: see figure 2 item 210 and paragraphs [0037-0038]: subscriber database (210D) stores identification information (i.e., identification code and telephone number) for the mobile terminals); a provider of the protected area requesting the authentication unit to determine the unique connection identifier of the second network using the unique identifier of the first network when the terminal would like access to the protected area (Nakajima: paragraphs [0038-0039]); authenticating the unique connection identifier of the second network and/or communicating the unique identifier of the second network to the provider of the protected area by means of the authentication unit (Nakajima: see paragraphs [0038-0039]); and checking whether an access right for the protected area exists for the unique connection identifier of the second network (Nakajima: paragraphs [0039-0040 and 0045-0046]).

Regarding claim 2, Nakajima teaches wherein the combination stored in the current authentication unit contains further data in addition (Nakajima: paragraph [0012]).

Regarding claim 3, Nakajima teaches wherein the additional data has at least one of the following: the dial-in number into the first network, a user name (login) and a password (Nakajima: see Abstract section and paragraph [0046]).

Regarding claim 4, Nakajima teaches wherein the authentication unit is only run temporarily (Nakajima: paragraphs [0042-0043]).

Regarding claim 5, Nakajima teaches wherein the combination of data is deleted from the authentication unit as soon as the terminal ends its connection with one of the two networks (Nakajima: paragraphs [0042-0043]).

Regarding claim 6, Nakajima teaches wherein the unique identifier of the second network is a call-up number (Nakajima: see Abstract section).

Regarding claim 7, Nakajima teaches wherein the protected area includes the provision of an online individual connection identification (Nakajima: paragraph [0055]).

Regarding claim 8, Nakajima teaches wherein an individual connection identification takes place automatically for the unique connection identifier of the second network (Nakajima: paragraph [0037]).

Regarding claim 9, Nakajima teaches wherein, before release of an individual connection identification, a further entry on the terminal is necessary (Nakajima: see Abstract section and paragraph [0041]).

Regarding claim 10, Nakajima teaches wherein the further entry includes the entry of an invoice number and/or a customer number and/or a PIN (Nakajima: see Abstract section and paragraph [0041]).

Regarding claim 11, Nakajima teaches wherein only authorized services have access to the authentication unit (Nakajima: paragraphs [0038-0039]).

Regarding claim 12, Nakajima teaches wherein the protected area includes at least one of the following services: provision of contents, electronic trade (e-commerce), payment or settlement services and authorized services (Nakajima: paragraph [0055]).

Regarding claim 13, Nakajima teaches wherein with a payment service, the costs arising are automatically invoiced by means of the unique connection identifier of the second network (Nakajima: paragraph [0041]).

Regarding claim 14, Nakajima teaches wherein further data are automatically called up from the terminal and/or further procedural steps are initiated in the protected

area using the unique connection identifier of the second network (Nakajima: see Abstract section).

Regarding claim 15, Nakajima teaches wherein further personalization of the terminal takes place by entering a PIN (Nakajima: paragraph [0032]).

Regarding claim 16, this claim has limitations that is similar to those of claims 1 and 5, thus it is rejected with the same rationale applied against claims 1 and 5 above.

Regarding claim 17, Nakajima teaches wherein at least one of the identifiers is an IP number and/or a unique connection identifier of a terminal (Nakajima: see Abstract section).

Regarding claim 18, Nakajima teaches wherein it is checked whether the enquiry originates from an authorized place or from an authorized service (Nakajima: paragraph [0045]).

Regarding claim 19, Nakajima teaches wherein the combination stored in the current authentication unit contains further information in addition (Nakajima: paragraphs [0038 and 0040]).

Regarding claim 20, Nakajima teaches wherein the additional data have at least one of the following: a dial-in number into one of the networks, a user name (login) and a password (Nakajima: see Abstract section and paragraph [0046]).

Regarding claim 21, Nakajima teaches wherein a call-up number block or a target number block is identified by means of the authentication unit (Nakajima: paragraph [0039]).

Regarding claim 22, Nakajima teaches wherein the first and second networks are based on different protocols (Nakajima: paragraph [0028]).

Regarding claim 23, Nakajima teaches wherein the first network is the internet, and the second network is a telephone network (Nakajima: see figure 1).

(10) Response to Argument

- 1. Claims 1-23 stand finally rejected under 35 U.S.C. 102(e) as being anticipated by Nakajima (US 2003/0169714) (hereinafter Nakajima).**

Appellants argue that the Nakajima reference does not disclose all elements recited in claim 1 and claim 16. Here is the list of arguments provided in the Appeal Brief regarding claim 1 and claim 16:

a. Regarding claim 1, appellants argue that Nakijima does not disclose or suggest the claimed “a provider of the protected area requesting the authentication unit to determine the unique connection identifier of the second network using the unique identifier of the first network when the terminal would like access to the protected area”.

Examiner respectfully disagrees. Nakijima discloses an authentication system which will perform user authentication for a mobile terminal when the mobile terminal requests access to the protected area (*Nakijima: See figure 2; paragraphs 0006 and 0033: an authentication step in which the subscriber system performs user authentication for the mobile terminal on the basis of the identification information of the mobile terminal included in the service request*). In order for the mobile terminal to get access to the protected area, the authentication system resided within a subscriber system will authenticate the mobile terminal using an IP address (i.e., unique identifier of the first network) of the protected area and a telephone number (i.e., unique connection identifier of the second network) of the mobile terminal (*Nakijima: paragraph 0014: identification information received by the receiving means includes an IP address; paragraph 0015: identification of the mobile terminal includes at least one of a telephone number; paragraph 0036: when a connection is established, service terminal 101 continuously sends information indicating a type of service that can be provided to a user(in this case, the service refers to a charged internet-connected service); paragraph*

0037: mobile terminal that has received the ID and the IP address of the service terminal, transmits a service request to subscriber system...the service request includes ...ID and an IP address of service terminal; paragraphs 0038-0040: identification unit 210, determining...telephone number included in the service request are stored in a subscriber database). In paragraphs 0038-0040 of Nakijima reference, these portions point out that the authentication unit determines the telephone number of the mobile terminal using the IP address embedded in the service request when the mobile terminal requests access to the protected area. Therefore, Nakijima clearly discloses the limitation claim 1.

b. Appellants further argue that Nakajima does not use "an IP address to determine the telephone number of the mobile terminal".

In response to appellants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*i.e., an IP address to determine the telephone number of the mobile terminal*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

c. Appellants further argue that contrary to the Examiner's assertion, it is clear that Nakajima does not use the IP address to perform authentication".

Examiner respectfully disagrees. Nakajima discloses in paragraphs 0037-0040 that the authentication unit determines the telephone number of the mobile terminal using the IP address embedded in the service request when the mobile terminal requests access to the protected area. Therefore, Nakajima clearly discloses using the IP address to perform authentication

d. Appellants further argue that Nakajima does not disclose or suggest the claimed "storage of a combination of at least the unique connection identifier of the second network by means of which the connection was made, and the unique identifier of the first network in an authentication unit".

Examiner respectfully disagrees. Nakajima discloses that the mobile terminal transmits the service request (*i.e., a service delivery point identification code identifying a service delivery point through which a service using the Internet is provided, specifically, ID and an IP address of service terminal; and also identification information of the mobile terminal, specifically, a network identification code and a telephone number of the mobile terminal*) to the communication unit of subscriber system, and

then the service request information comprising IP address and telephone number gets stored at the subscriber system. The subscriber system then uses the information embedded in the service request which comprises the telephone number and the IP address to authenticate the mobile terminal (*Nakajima: paragraphs 0037-0040*).

- e. Appellants further argue that Appellants invention is about the stored combination of identifiers comes from different networks, unlike Nakajima invention the stored combination of identifiers from the same network.

Examiner respectfully disagrees. Nakajima discloses that the mobile terminal transmits the service request (*i.e., a service delivery point identification code identifying a service delivery point through which a service using the Internet is provided, specifically, ID and an IP address of service terminal; and also identification information of the mobile terminal, specifically, a network identification code and a telephone number of the mobile terminal*) to the communication unit of subscriber system, and then the service request information comprising IP address and telephone number gets stored at the subscriber system (*Nakajima: paragraph 0038*). Nakajima further discloses the stored combination of identifiers comes from different networks (*Nakajima: See figure 2; paragraphs 0025 and 0037-0038*). Examiner notes that the telephone network recited in Nakajima reference is the first network and the Internet recited in Nakajima reference is the second network (*Nakajima: See figure 1; paragraph 0017: a*

mobile communication utilizing a first network...a service delivery point through a service (i.e., Internet) using a second communication network is provided). Therefore, based on the first network and the second network of Nakajima reference, Nakajima does teach the stored combination of identifiers comes from different networks.

f. Regarding claim 16, appellants argue that Nakajima reference does not disclose or suggest “deletion of data from the authentication unit as soon as a connection with at least one of the two networks has ended”.

Examiner respectfully disagrees. Examiner would like to point out that when a session has ended, certain system will delete the data of that session because leaving session data available in computer memory when it should be deleted represents security risks as well as an inefficient use of the computer resources. Nakajima discloses that the session is terminated between the service terminal and the Internet which implies the data of that session will be deleted (*Nakajima: paragraph 0044*). Therefore, Nakajima does teach the limitation of claim 16.

g. Appellants further argue that the Nakajima reference does not disclose or suggest “storage of a combination of the unique identifiers in an authentication unit”.

Examiner respectfully disagrees. In paragraphs 0037-0038 of Nakajima reference, the mobile terminal has received the ID and IP address of the service terminal, and transmitted the service request which includes the telephone number of the mobile terminal and the IP address of the service area to the authentication/identification unit of the subscriber system. Examiner notes the subscriber system will store the telephone number of the mobile terminal and the IP address of the service area for authentication purposes.

2. Regarding claims 2-15 and 17-23, Appellants' arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Trang Doan/

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